

Claims Rejection Under 35 USC Section 103, Paragraphs 1, 2, 3, 4, 5 and 6 of the First Office Action (pages 2 through 12 of the First Office Action)

5 The Examiner presently rejects claims 1 through 15 as lacking “non-obviousness” primarily over US Pat. Publication No. 2003/0173743 (Brink et al) in view of Moragne et al, US Pat. Publication No. 2002/0107947.

10 It is important to understand the nature of beauty contests in traditional practice. The present invention is not a normal contest for individuals who are comparable in age. That is, a traditional beauty contest may be held on a certain date and may be open to “Children ages 6 through 12 years of age as of the date of the contest”. Such contests may be held live or on-line. This was pointed out at length in the Background of the Invention section of the present application, from the second paragraph through the seventh paragraph, and elsewhere in the application. The present invention however claims an overall method for conducting a “Child of 15 All Time” type beauty pageant, in which images of children from any time may be compared. In the present instance, the competition is not for a particular age of individuals at a particular time but rather for individuals who may be any age as of the date of the contest, as noted in the first paragraph of the General Summary of the invention.

20 In particular, the present invention specifically discloses and claims the following concept: “from any time since the inception of photography”. This term is found in the first line of the body of Claim 1. In regard to this term, the First Office Action states as follows: “accepting images from any time” (see paragraph 0012, lines 5-8) [of the Brinks et al reference].

But the cited paragraph 0012 contains no discussion of time whatsoever and thus does not provide adequate support for the rejection of the limitation cited. In the First Office Action, the Patent Office has repeatedly stated that this limitation is not present in the cited prior art, and furthermore did not make any further finding regarding the limitation.

5 In the interests of speeding prosecution, the applicant first assumed that a trivial typographic error had been made and some other paragraph had been actually cited by the Office Action. On this basis the applicant proactively computer searched the reference document (Brinks et al) for ALL references to time, years, or other less relevant terms, in addition to reading it normally.

10 No relevant references are found in the document. All references in Brinks et al to “time” in fact refer to specific times, which in fact are specific times when players play the game, not to anything relevant to age of the cattle to be examined. Thus not only are the references in Brinks et al irrelevant, they also teach away from the broad and unique limitation of “any time since the inception of photography.”

15 Other Prior Art Already of Record

No other prior art cited appears to contain these words of limitation either.

In the interest of speeding prosecution, the applicant notes that US Patent No. 6247009 to Shiiyama, while not specifically discussed, is referenced by the Examiner, and contains
20 confusing language regarding time of display of images. For clarity, applicant will note that this application mentions that images may be sorted for display based upon a time factor related to

how long the image has been on display. However, there is no mention of accepting images from any time since the inception of photography to have a contest for “children from all time”.

No Prime Facia Case

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The courts have held that the Patent Office is expected to make a case for non-obviousness. This “Prime Facia” case is discussed in the law. The analysis by the Office must be made on a limitation by limitation basis, for example as discussed in *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.* 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Circ. 1984) and *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ 2d 1030 (Fed. Cir. 1997).

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In the present case, the Office has identified a significant limitation of the invention but has not dealt with it by showing it in the prior art.

Discussion of Potential Patent Office Arguments Regarding the Limitation

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In the interest of speeding prosecution, the applicant will proactively consider potential arguments the Office commonly makes regarding obviousness of a limitation which cannot be found in the prior art.

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Inherency

A first (proactive) suggestion is that a limitation is “inherent” in a cited reference.

However:

However the doctrine of inherency is only applicable to cases in which an element of an invention is actually present in the reference and in which it is merely not discussed. In particular, in order to use the doctrine of inherency to fill a gap in a reference's teaching: "the missing descriptive matter is necessarily present in the thing described in the reference" and "evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference" (*Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, Fed. Cir. 1991).

Obviously, the "inception of photography" aspect of the present invention, allowing a child beauty contest for individuals of ANY age, is quite obviously not necessarily present in the cited prior art, which appear to discuss normal contests having limited durations for applicant images.

Obvious to One Skilled in the Art, without support

Another potential Patent Office argument (not made by the Office in the present case) is to state that a limitation would have been obvious to one skilled in the art, although applicant is unaware of further support for such statement. However:

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420

(CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

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and more importantly:

In re Kahn, 441 F.3d 977, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), “Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.”

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In fact, the above citation is quoted in the recent leading case handed down by the Supreme Court, *KSR*, 550 US ___, 82 USPQ2d at 1396.

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Thus, if the Office had made that argument in the present Office Action, the *KSR* and *Kahn* cases would argue that some rationale as to WHY the limitation would have been obvious would be required from the Office.

Since beauty contests are normally carried out between people of the same age at the time of the contest, this flies in the face of reality.

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Additionally, since the Office noted that the limitation was not present, it seems reasonable to believe that the limitation is not one the Office believed to be obvious by itself.

Simplicity

The new concept of the invention, the “Baby Picture of All Time” contest, is fairly simple. However, as the CAFC stated in *In re Oetiker* 977 F. 2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992), “It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected to be motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant’s invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness... **Oetiker’s invention is simple. Simplicity is not inimical to patentability.**”

Additional Prior Art


Finally, the Office may well search further for prior art containing the “any time since the inception of photography” concept. However, in that event, Final status on Second Action becomes inappropriate. According to MPEP 706.07(a):

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”

The applicant has not amended the claims, and the Office has not yet made ANY ground of rejection of the limitation at issue here, thus ANY ground of rejection is new. Thus should the Office elect to search again, the applicant feels that Final status is against Office Rules.

Conclusion

For all the foregoing reasons, applicant very respectfully urges that the application is now in condition for immediate allowance, and such action is requested. The Examiner is respectfully urged to contact applicant's counsel, Craig W. Barber, PO Box 16220, Golden, Colorado, 80402-6004, 303-278-9973, fax 303-278-9977, with any questions or comments.

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